

Appln. No. 09/888,247  
Reply dated Jan. 20, 2006 to  
Interview Summary dated Dec. 20, 2005  
Docket No. 6169-190

IBM Docket No. BOC9-2000-0055

### **REMARKS/ARGUMENTS**

These remarks are filed in response to Applicant's receipt of the Interview Summary dated December 20, 2005. As this response is timely filed within the 1-month shortened statutory period, no fee is believed due.

Applicant initially wishes to express appreciation for the Examiner's taking time to discuss the case with Applicant's representative by phone on December 8, 2005, and for the remarks set forth in the Interview Summary. Per the Examiner's instructions, Applicant hereby re-submits the exhibits that were previously submitted under seal and filed concurrently with Applicant's Response to Office Action dated September 19, 2005. The referenced exhibits are submitted in support of the Applicant's 1.131 Declaration stating that Applicant's invention predates U.S. Patent No. 6,868,434 to Terranova, *et al.* (hereinafter Terranova). The exhibits are submitted with the understanding that the exhibits will become part of the record of the case.

### **Applicant's Invention Predates Terranova**

Applicant respectfully asserts that Terranova is not prior art as to Applicant's invention. Submitted herewith is Applicant's Declaration pursuant to 37 C.F.R. § 1.131 supporting the removal of Terranova as a reference. Applicant's Declaration is accompanied by a copy of Confidential Invention Disclosure No. BOC8-2000-0046 (hereinafter "Disclosure") entitled "Low-Cost Monitor and Alert Application for Global Merchant Service." The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicant's invention at least as early as April 27, 2000, which predates the August 7, 2000 effective date of Terranova. Additionally submitted herewith is evidence of activity on specific dates that show Applicant's continued diligence from prior to the effective date of Terranova.

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The present application, including each claim, is based upon Applicant's Disclosure. Applicant's employer and assignee of the present application, International Business Machines (IBM), establishes rigorous procedures governing the use of such disclosures, generally. The inventor submitted the Disclosure on April 28, 2000, to an IBM Attorney/Patent Professional. IBM's own procedures preclude substantive modification of such a disclosure once submitted, and, as Applicant affirms in the accompanying Declaration, the Disclosure was not substantively modified following its submission to the IBM Attorney/Patent Professional. The inventor reviewed the present application prior to its submission to the U.S. Patent and Trademark Office so as to insure that the claims and subject matter contained therein were fully supported by the Disclosure.

Each of the claims in the application is fully supported in the Disclosure, including the aspects of response, or latency, times and the use of status arrays. (See, e.g., p. 2, paragraph 5.) The Figure contained in the Disclosure is virtually identical to FIGs. 2 and 3 in the application.

Applicant exercised due diligence from prior to the effective date of Terranova continuously to June 22, 2001, when the present application was filed. With respect to Applicant's diligence it is to be noted that, as set forth in the Declaration, once an IBM invention disclosure form is completed, the disclosure is reviewed by an Invention Review Board (hereinafter the "Board") within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon the Board's reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel.

In this instance, during the period between April 28, 2000, and June 22, 2001, the Board conducted an inquiry as to the patentability of the invention and assigned the

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Docket No. 6169-190

IBM Docket No. BOC9-2000-0055

application to outside counsel to prepare a patent application based on the Disclosure. As is a common practice in the profession, outside counsel prepares cases on a "first come, first served" basis unless a bar date dictates that the preparation be given priority within the work queue. As proof that the present application was included within the work queue and receiving due attention, Applicant provides herewith pages from their Firm Docket regarding the application [outside counsel docket number 6169-190], dated January 2, 2001, March 2, 2001, April 2, 2001, May 2, 2001, and June 2, 2001 (redacted to insure confidentiality of other Firm clients and attached as part of the Composite Exhibit).

Outside counsel iteratively reviewed and revised the drafted application with the inventor. This activity during the pertinent period is consistent with the legal requirements for a showing of diligence noted, for example, in MPEP § 715.07(a). As proof of diligence-evidencing activities, Applicant refers the Examiner to the following documents which are also contained in Composite Exhibit, attached hereto:

1. October 2, 2000, correspondence from IBM requesting the preparation of a patent application based on the Disclosure;
2. October 11, 2000, correspondence from the outside counsel to IBM in-house counsel confirming receipt of the disclosure and instructions to prepare a patent application based thereon;
3. May 11, 2001, correspondence from outside counsel to the inventor forwarding a draft of the present application for the inventor's review and facsimile confirmation sheet;
4. June 21, 2001, correspondence from outside counsel forwarding the final draft of the application and facsimile confirmation sheet.

Applicant respectfully maintains that the evidence provided clearly establishes reasonable diligence from a time prior to the effective date of Terranova to the filing date

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of the present application. Applicant further respectfully maintains that the evidence shows that Applicant's diligence was exercised in constructively reducing the invention to practice between the date of the Disclosure, until the filing date of the present application. Accordingly, Applicant respectfully requests that Terranova be withdrawn as a reference.

### Conclusion

Applicant believes that this application is now in full condition for allowance, which action is respectfully requested. The Applicant requests that the Examiner call the undersigned if clarification is needed on any matter within this Response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

The Examiner's assistance in expediting prosecution of the application is greatly appreciated.

Respectfully submitted,

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